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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,980	03/15/2005	Adalbert Huber	MERCK-2981	1788
23599	7590	12/16/2008		EXAMINER
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				HAILEY, PATRICIA L
			ART UNIT	PAPER NUMBER
			1793	
MAIL DATE	DELIVERY MODE			
12/16/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,980	<b>Applicant(s)</b> HUBER ET AL.
	<b>Examiner</b> PATRICIA L. HAILEY	<b>Art Unit</b> 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 November 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,6,7,9 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,6,7,9,11-13,16-19,21-24 and 26 is/are rejected.
- 7) Claim(s) 15, 20, and 25 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2008, has been entered.

Applicants' submission includes an amendment, in which claims 2-5 have been canceled, and new claims 22-26 have been added.

Claims 1, 6, 7, 9, and 11-26 remain pending in this application.

***Election/Restrictions***

2. Claim 14 remains withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method for light protection or corrosion protection, there being no allowable generic or linking claim.

Claim 14 was withdrawn as a result of an election by original presentation in the Office Action mailed June 25, 2007.

Claims 1, 6, 7, 9, 11-13, and 15-26 remain under consideration by the Examiner.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on March 15, 2005.

***Withdrawn Rejections***

The rejections of record stated in the Final Rejection mailed on August 12, 2008, have been withdrawn in view of Applicants' amendments, and in view of Applicants' persuasive arguments traversing said rejections.

***New Ground of Rejection***

The following New Ground of Rejection is being made in view of Applicants' amendments, and in view of the Examiner's reconsideration of the reference to Schauer et al. (U. S. Patent No. 6,686,046).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

4. Claims 1, 6, 7, 9, 11-13, 16-19, 21-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schauer et al. (U. S. Patent No. 6,686,046).

Schauer et al. disclose particles provided with a coating of LCST polymers (**claims 1 and 26**), prepared by dissolving an LCST polymer in a solvent at a temperature below the LCST, mixing the particles with the resulting solution, and raising the temperature of the resulting mixture to, and optionally beyond, the temperature at which the LCST polymer deposits onto the particle surfaces. See col. 1, lines 48-55 of Schauer et al. (considered to read upon **claim 19**), as well as col. 2, lines 21-55, which also discloses that the resultant LCST polymer coating applied to the particles exhibits thicknesses preferably greater than or equal to 50 nm (considered to read upon **claims 1 and 22**), and further discloses that the aforementioned coating process "is very preferably carried out such that subsequently to or during formation of the coating the LCST polymer is rendered immobile on the surface of the substrates to be coated therewith", said immobilizing being rendered either by cross-linking the coating (col. 2, lines 55-60), or by thermodynamically immobilizing the polymer (col. 3, lines 24-32; considered to read upon **claims 16-18, 21, 23, and 24**).

Exemplary particles that can be coated include pigments. See col. 1, line 66 to col. 2, line 9 of Schauer et al., which also discloses titanium dioxide and iron oxide as specific examples of pigments (**claim 9**).

The pigments coated by the LCST polymers can be used to produce binder-free pigment pastes containing a carrier medium, preferably water or an organic solvent, which by reason of their freedom from binding agents can be used universally in paints

and varnishes. See col. 4, lines 5-17 of Schauer et al. (considered to read upon claims 12 and 13).

Examples of the LCST polymers are the same as those recited in Applicants' claim 1. See col. 4, lines 31-40 of Schauer et al.

Schauer et al. at col. 4, lines 18-25 disclose the feasibility in incorporating functional components such as UV stabilizers, chromophores, or luminescent components into the LCST coating. This disclosure is considered to read upon claims 6 and 11.

Regarding claim 7, one of ordinary skill in the art would be motivated by the teachings of Schauer et al., and find reasonable expectation in determining through routine experimentation the optimal amounts of additives such as UV stabilizers, chromophores, or luminescent components into the LCST coating.

Lastly, Schauer et al. at col. 4, lines 28-30 disclose that "coating with LCST polymers may also serve to modify the particle surface..."; this disclosure is considered to read upon the claim limitation "surface-modified".

Although Schauer et al. do not explicitly disclose the employment of UCST polymers, as recited in the instant claims, it is noted that these polymers are referred to in the alternative (i.e., "LCST *and/or* UCST polymer", emphasis added by the Examiner). Therefore, the teachings of Schauer et al. as set forth above are considered to read upon Applicants' claims in their present form.

Further, although Schauer et al. do not explicitly disclose the effect pigments recited in claim 1, it would have been obvious to one skilled in the art to select any known pigments to be coated, motivated by the teachings of Schauer et al. that coating pigment particles with LCST polymer "can improve the compatibility of the particles with the vehicle or matrix, ie (sic) the particles can be rendered compatible with aqueous media or organic media regardless of the nature of the particles." See col. 2, lines 10-19 of Schauer et al.

*Response to Arguments*

Applicants' arguments regarding the references to Glausch et al. and Winter et al. are persuasive. However, with respect to Schauer et al., Applicants' arguments regarding this reference are not persuasive, as Applicants' claims refer to the LCST and UCST polymers in the alternative ("and/or"). As such, pigments coated with only LCST polymers are considered to read upon Applicants' instant claims.

For these reasons, Applicants' arguments are not persuasive.

*Allowable Subject Matter*

5. Claims 15, 20, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

Schauer et al. do not teach or suggest the coating of pigment particles with UCST polymers.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA L. HAILEY whose telephone number is (571)272-1369. The examiner can normally be reached on Mondays-Fridays, from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PATRICIA L. HAILEY/  
Examiner, Art Unit 1793  
December 13, 2008